

REMARKS

This Amendment is submitted in response to the Office Action dated December 7, 2000. In the Office Action, the Patent Office stated that the reissue oath/declaration was defective since, the Patent Office contends, it failed to identify at least one specific error which was relied upon to support the reissue application under 37 CFR §1.175(a)(1) and MPEP §1414. Further, the Patent Office rejected Claims 21-50 under 35 U.S.C. §251 as being based upon a defective reissue declaration and for improperly recapturing claimed subject matter deliberately surrendered in the application for the patent upon which the present reissue is based. Applicants note with appreciation that the Patent Office approved the proposed drawing corrections to Figures 5A, 6, 7C, 8C, and 9C.

Applicants further note with appreciation the Patent Office's allowance of Claims 1-20. However, Applicants submit the reasons given for allowance of Claims 1-20 were made in error. In paragraph 4 of the Office Action dated December 7, 2000, Examiner Smits stated:

Specifically, the sole independent claim 1 of the CIP application was allowed because "it recites storing at predetermined addresses in an analog memory contained in a model train a plurality of sound effects, controlled by an integrated analog-sound/motor/special-effects controller which uses bi-polar digital signal packets to, *inter alia*, recall for playback said analog sound effects from said memory in a predetermined or a random sequence, when the corresponding digital packet triggers its sound effect".

The reasons for allowance stated by Examiner Smits in paragraph 3 of the Notice of Allowance include:

As per the revised sole independent claim 1, it recites storing at predetermined addresses in a sound memory contained in a model train a plurality of sound effects, controlled by an integrated analog-sound/motor/special-effects controller which uses bi-polar digital signal

packets to , *inter alia*, recall for playback said analog sounds effects from said memory in a predetermined or a random sequence, when the corresponding digital packet triggers its sound effect. The prior art of record, including the National Model Railroad Association's Digital Command Control (DCC) Standards and Recommended Practices, and Seversons et al.'s newly cited U.S. Patent 5,773,939, do not teach or suggest using the known DCC bi-polar digital signal packets for controlling the playback of a predetermined or random sound effect sequence form (a sequence) of predetermined addresses in a sound memory on board a model train. Thus, claim 1 is allowable.

In actuality, Claim 1, as issued, recites:

A sound reproducing system for a model train traveling on a plurality of rails that uses a amplified digital control signal for propulsion and control, the system comprising: a sound memory storing a plurality of sound effects at predetermined addresses; a controller connected to the sound memory for recalling the sound effects of either one or a plurality of sound effects in a predetermined sequence or a random sequence; a sound memory containing multiple samples that emulate a model locomotive at various speeds and work loads; an integrated sound, motor and special effects controller controlled by a bi-polar digital signal, the motor and special effects controller re-producing the stored sounds contained in the model train; and a digital packet triggering a sound effect for automatic playback of a sound effect.

The word "analog" is not part of Claim 1. In fact, the Amendment received by the U.S. Patent Office on April 16, 1998, deleted all occurrences of "analog" in Claims 1, 3, 6 and 12. However, as Examiner Smits noted in the Notice of Allowance, the prior art of record do not teach or suggest using the known DCC bi-polar digital signal packets for controlling the playback of a predetermined or random sound effect sequence form of predetermined addresses in a sound memory on board a model train. Thus, Applicants submit that Examiner Smits erred in statements regarding reasons for allowance of Claim 1. Nonetheless, Claim 1 remains allowable as no reference of record teaches or suggests the features of Claim 1. Notice to that effect is requested.

By the present Amendment, Applicants amended Claims 12 to correspond to the amendments made to Claim 12 in the Office Action dated May 6, 1998. The Amendment, however, was not incorporated by the Patent Office in the issued patent. Further, by the present Amendment, Applicants amended the reissue oaths/declarations and Claim 21 to overcome the rejections of the Patent Office. Applicants submit that the application is now in condition for allowance in view of the present amendments and for the reasons that follow.

In the Office Action, the Patent Office declared the reissue oath/declaration to be defective because, the Patent Office contends, they failed to identify at least one specific error which was relied upon to support the reissue application under 37 CFR §1.175(a)(1) and MPEP §1414. More specifically, the Patent Office found that the error listed in the declaration by Applicants' general statement was too vague and indefinite. The Patent Office stated that Applicants should specifically indicate how the sole independent claim was unnecessarily narrowed.

By the present Amendment, Applicants submit supplemental oaths/declarations by each inventor to specify at least one error. Namely, each declaration submits that the original patent fails to claim, for example, in original Claim 1, and as now defined in amended independent Claim 21, a sound reproducing system for a model train traveling on a plurality of rails that uses an amplified digital control signal for propulsion and control. The sound reproducing system is comprised of a sound unit, a memory within the sound unit, and a controller connected to the memory.

The memory stores a plurality of sound effects at addresses wherein the sound effects contain multiple samples that emulate a train locomotive at various conditions. The memory has an analog wave form representing sound effects of a locomotive at various conditions and work loads or a digital representation of the analog wave form that represents a plurality of sound effects of a locomotive at various conditions and work loads. The controller is connected to the memory for recalling at least one of the sound effects and the controller is controlled by a digital signal.

The error of failing to state in Claim 1 of the original patent that which is recited in amended Claim 21 was made unintentionally and with no intention to deceive or mislead the United States Patent and Trademark Office, and, thus, without any deceptive intention. Applicants did not appreciate that they were entitled to a claim of the scope of newly added Claims 21 and Claims 22-50 dependent therefrom. Accordingly, Applicants submit that the reissue oaths/declarations filed with this Amendment overcome the objections of the Patent Office under 37 CFR §1.175(a) and MPEP §1414. Notice to that effect is requested.

Further, the Patent Office rejected new Claims 21-50 under 35 U.S.C. §251 as being based upon a defective reissue declaration. However, by the present Amendment, Applicants amended the reissue declarations to remove any defects. Therefore, the rejections of the claims under 35 U.S.C. §251 as being based upon a defective reissue declaration have been overcome. Notice to that effect is requested.

Still further, the Patent Office rejected new Claims 21-50 under 35 U.S.C. §251 for improperly recapturing claimed subject matter deliberately surrendered in the application for patent upon which the present re-issue is based. Applicants respectfully submit that the subject matter defined by amended independent Claim 21 was not included and, therefore, could not have been surrendered in the application for patent upon which the present re-issue is based. Thus, Claim 21 does not claim subject matter deliberately surrendered in the application for patent upon which the present re-issue is based.

Namely, Claim 21 defines a sound reproducing system for a model train traveling on a plurality of rails that uses an amplified digital control signal for propulsion and control. The sound reproducing system is comprised of a sound unit, a memory within the sound unit, and a controller connected to the memory. The memory stores a plurality of sound effects at addresses wherein the sound effects contain multiple samples that emulate a train locomotive at various conditions. The memory has an analog wave form representing sound effects of a locomotive at various conditions and work loads or a digital representation of the analog wave form that represents a plurality of sound effects of a locomotive at various conditions and work loads. The controller is connected to the memory for recalling at least one of the sound effects and the controller is controlled by a digital signal.

Specifically, as stated above, the original patent failed to claim in the application upon which the present re-issue is based, and as now defined in amended independent Claim 21, a memory

storing a plurality of sound effects at addresses wherein the sound effects contain multiple samples that emulate a train locomotive at various conditions and further wherein the memory has an analog wave form or a digital representation of the analog wave form representing sound effects of a locomotive at various conditions and work loads. Further, the original patent failed to claim a controller connected to the memory for recalling the sound effects wherein the controller is controlled by a digital signal. Applicants failed to claim and/or appreciate that they were entitled to claims of this scope. Moreover, Applicants did not have a claim of the scope defined by amended independent Claim 21. Accordingly, Applicants are not attempting to recapture previously claimed subject matter.

In view of the foregoing, the rejection under 35 U.S.C. §251 has been overcome. Applicants submit that amended Claim 21 is now allowable. Notice to that effect is requested.

Claims 22-50 depend from Claim 21. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claim since each sets forth additional novel elements of Applicants' invention.

In view of the foregoing remarks and amendments, Applicants respectfully submit that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicants urge the Patent Office to telephone Applicants' attorney so that the same may be resolved and the application expedited to issue.

Applicants request the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** and the **Inventors' Supplemental Declarations** are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Asst. Commissioner for Patents, Box Reissue, Washington, D.C. 20231 on March 07, 2001.



Brian M. Mattson